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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/867,923	05/30/2001	Matthew S. Meyerson	FIS920010070US1	7553

29505 7590 07/08/2004		EXAMINER
DELIO & PETERSON, LLC		GORDON, CARLENE MICHELLE
121 WHITNEY AVENUE		
NEW HAVEN, CT 06510	ART UNIT	PAPER NUMBER
	2124	

DATE MAILED: 07/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/867,923	MEYERSON, MATTHEW S.
	Examiner	Art Unit	
	Carlene Gordon	2124	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>*30 May 2001*</u>.
2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
   closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-26* is/are pending in the application.
   4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) *1-26* is/are rejected.
7)☒ Claim(s) *19* is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.
10)☒ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☒ objected to by the Examiner.
   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
   a)☐ All   b)☐ Some * c)☐ None of:
      1.☐ Certified copies of the priority documents have been received.
      2.☐ Certified copies of the priority documents have been received in Application No. _____.
      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
         application from the International Bureau (PCT Rule 17.2(a)).
   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
   Paper No(s)/Mail Date <u>*05/30/2001*</u>.
4) ☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____ .

DETAILED ACTION

1.   This is responsive to the application filed on May 30, 2001.

Claims 1-26 have been submitted for examination.

Drawings

2.   The drawings are objected to because step 28 of Fig. 1 recites the term limit, a

term not defined in the specification or corresponding with the claim language.

Corrected drawing sheets are required in reply to the Office action to avoid

abandonment of the application. Any amended replacement drawing sheet should

include all of the figures appearing on the immediate prior version of the sheet, even if

only one figure is being amended. The figure or figure number of an amended drawing

should not be labeled as "amended." If a drawing figure is to be canceled, the

appropriate figure must be removed from the replacement sheet, and where necessary,

the remaining figures must be renumbered and appropriate changes made to the brief

description of the several views of the drawings for consistency. Additional replacement

sheets may be necessary to show the renumbering of the remaining figures. The

replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as

per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the

changes are not accepted by the examiner, the applicant will be notified and informed of

any required corrective action in the next Office action. The objection to the drawings

will not be held in abeyance.

Specification

3.   The disclosure is objected to because of the following informalities:

Spacing of "block" and "42" (pg. 11, line 24).

Spacing of "block" and "32" (pg. 12, line 3).

Appropriate correction is required.

Claim Objections

4.   Claim 19 is objected to under 37 CFR 1.75(c), as being of improper dependent

form for failing to further limit the subject matter of a previous claim. Applicant is

required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper

dependent form, or rewrite the claim(s) in independent form.

Claim 17 teaches a single publisher while claim 19 teaches a plurality of

publishers. The plurality of publishers of claim 19 broadens the scope of claim 17,

therefore, expanding the claim instead of further limiting the subject matter.

Claim Rejections - 35 USC § 102

5.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public
use or on sale in this country, more than one year prior to the date of application for patent in the United
States.

6.   Claims 1-8, 12-13, 20, and 22-26 are rejected under 35 U.S.C. 102(b) as being

anticipated by **Cole et al.** (U.S. Patent No. **5,752,042**), hereafter "Cole".

7.   As to claim 1, Cole teaches:

downloading software update information through a network to the computer (col.

3, lines 35-40, "client downloads update manager, …");

determining if a software update is available from the software update

information (col. 4, lines 2-8, "table list code updates available");

downloading a criticality check program through the network to the computer (col.

3 lines 40-44, "client downloads recognizer program from server"; Fig. 3a);

executing the criticality check program on the computer (col. 3, lines 40-44,

"…and executes it"; Fig. 3a);

evaluating the criticality of the software update from an output of the criticality

check program and the software update information (col. 3, line 52 – col. 6, line 30; col.

3, lines 52- 54, "sends information obtained by recognizer program"; col. 6, lines 1-4

"determines the level of criticality");

accessing stored user preference information (col. 3, lines 42-52, "obtains basic

system information about the client"; Abstract, "user selects from a list and sends"); and

determining if the software update should be automatically downloaded and

installed from the user preference information and the evaluated criticality of the

software update (col. 5, line 55 – col. 6, line35, "results include yes/no answers whether

code update is appropriate for client", "assign critical level for each code update based

on the need of the client for the update"; Abstract, "in response to user selection, server sends code update addresses").

8.   As to claim 2, Cole further teaches the software update information includes a criticality rating (col. 5, line 55 – col. 6, line7, "assign a critical level to each code update", "server determines level of criticality of code updates for display at client").

9.   As to claim 3, Cole further teaches wherein the step of executing the criticality check program on the computer includes determining the configuration of the computer (col.3, lines 40-50, " recognizer program obtains basic system information about client") and the step of evaluating the criticality of the software update includes adjusting the criticality rating from the software update information dependent upon the configuration of the computer to produce the evaluated criticality of the software update (col. 3, lines 60-62, "assign a critical level based on the need of the client").

10.   As to claim 4, Cole further discloses wherein the user preference information includes a user criticality threshold and the step of determining if the software update should be automatically downloaded and installed includes comparing the user criticality threshold and the evaluated criticality of the software update (col. 5, lines 60-65, "The recognizer... in client"; col. 6, lines 1-20, "minimum number of code updates").

11.   As to claim 5, Cole further teaches wherein the software update information

includes a location for downloading the criticality check program (col. 3, lines 28-42,

"addressing information for the recognizer program").

12.   As to claim 6, Cole further teaches wherein the step of downloading the criticality

check program includes downloading the criticality check program from the criticality

check program location (col. 3, lines 28-44, "furnishing addressing information",

"downloads recognizer program from server").

13.   As to claim 7, Cole further teaches wherein the software update information

includes a location for downloading the software update (col. 6, lines 26-30, "server

sends FTP addressing information for the code updates").

14.   As to claim 8, Cole further discloses downloading the software update from the

software update location; and automatically installing the software update (col. 6, lines

26-50, "Using FTP addressing, client downloads code updates", "client installs code

updates").

15.   As to claim 12, Cole further discloses the step of producing a notification if it is

determined from the user preference information and the evaluated criticality of the

software update that the software update should not be automatically downloaded and

installed (col. 4, lines 53-58, "be noted... which of the code updates that are consistent";

col. 3, lines 56-67 & col. 6, lines 1-58).

16.   As to claim 13, Cole further discloses the step of determining from the software

update information whether to skip the steps of downloading and executing the criticality

check program and evaluating the criticality of the software update (col. 4, lines 40-45,

"no recognizer program is fetched"), and wherein the step of determining if the software

update should be automatically downloaded and installed comprises comparing a user

criticality threshold included in the user preference information with a criticality rating

included in the software update information. (This claim is also rejected under the same

rationale as claims 3 and 4).

17.   As to claims 22, 23, and 24, rejection of claim 1 is incorporated and further

claims 22, 23, and 24 recite limitations as recited in claim 1, therefore, claims 22, 23, 24

are rejected under the same rationale as claim 1.

18.   As to claims 20, 25, and 26, rejection of claims 1, 2, 4, 8, 12, and 13 are

incorporated and further claims 20, 25, and 26 recite limitations as recited in claims 1, 2,

4, 8, 12, and 13, therefore, claims 20, 25, and 26 are rejected under the same rationale

as claims 1, 2, 4, 8, 12, and 13.

Claim Rejections - 35 USC § 103

19.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

20.   Claims 14-16, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Cole.

21.   As to claim 14, Cole discloses that it is well known in the art at the time of the

invention that downloading software update information comprises periodically

automatically downloading software update information through the network to the

computer (col. 1, lines 30-35, "whenever server obtains a new update, server

automatically sends update to client").

22.   As to claim 15, Cole further discloses that it is well known in the art at the time of

the invention that downloading software update information includes sending a software

update query through the network requesting the software update information (col. 1,

lines 36-37, "client request all updates").

20.   As to claim 16, Cole further teaches the software update query includes software

identification information identifying software to be updated and the software update

information relates to the software to be updated identified in the software identification

information (col. 1, lines 36-37, shows "client identifying updates requested, and the

server responds accordingly", col. 1, line 54, "identified code updates", lines 59-60,

"server sends information about the list to the client").

23.   As to claim 21, rejection of claims 1, 2, 4, 5, 7, and 14 are incorporated and

further claim 21 recites limitations as recited in claims 1, 2, 4, 5, 7, and 14, therefore,

claim 21 is rejected under the same rationale as claims 1, 2, 4, 5, 7, and 14.

24.   Claims 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Cole as applied to claim 8 above, and further in view of **Fawcett** (U.S. Patent No.

5,845,077), hereafter "Fawcett".

25.   As to claim 9, Fawcett teaches the step of producing a notification that the

software update has been installed (col. 10, lines 5-8, "log is created... software

installed").

It would have been obvious to one of ordinary skill in the art at the time of the

invention to produce a notification that software is installed because it allows the user to

determine available software on the computer and it is a well-known practice in the art

to produce this notification.

26.   As to claim 10, Cole further discloses the steps of determining if a computer

reboot is necessary and including a request in the notification that the computer be

rebooted if a computer reboot is necessary (col. 6, lines 52-55, "client is requested to reboot").

27.   As to claim 11, Fawcett further discloses step of notifying the user of the availability of additional software updates (Abstract, "alert user to new products...").

It would have been obvious to include in the invention of Cole which indicates the code updates that are potentially appropriate for the client (col. 3, lines 65-67), an indication of the availability of new additional software updates, because the user will always have the most up-to-date computer software immediately available. Also, this inclusion offers a saving in advertising costs for the software developers.

28.   Claims 17 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cole as applied to claim 15 above, and further in view of **Pedrizetti et al.** (U.S. Patent No. **6,151,708**), hereafter "Pedrizetti".

29.   As to claims 17, Cole discloses a software update query but not a query for updates including software publisher information identifying a publisher of software to be updated and the software update information includes a list of software updates available for software published by the publisher identified in the software identification information. However, Pedrizetti teaches the significance of a Dynamic Linked Library

written by the vendor on the server computer associating a vendor to the updates to be downloaded by that particular vendor (col. 6, lines 1-14).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the query of Cole to request updates by a particular publisher because it would have facilitated in determining if the requested program updates are available from the particular server, and Pedrizetti's method allows for writing programs specifically tailored to a specific update.

30.   As to claim 19, since claim 19 is an obvious variation over claim 17, rejection of claim 17 is incorporated and further claim 19 recites limitations as recited in claim 17, therefore, claim 19 is rejected under the same rationale as claim 17.

31.   Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cole and Pedrizetti as applied to claim 17 above, and further in view of Fawcett.

32.   As to claim 18, Fawcett further teaches the step of determining if a software update is available from the software update information comprises determining from the list of software updates if a software update is available for software on the computer (col. 6, lines 20-32, "summary contains information on software available... will be listed in summary").

Any inquiry concerning this communication or earlier communications from the
examiner should be directed to Carlene Gordon whose telephone number is (703) 605-
4226. The examiner can normally be reached on Mon.-Fri. 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's
supervisor, Kakali Chaki can be reached on (703) 305-9662. The fax phone number for
the organization where this application or proceeding is assigned is 703-872-9306.

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Business Center (EBC) at 866-217-9197 (toll-free).

C.G. / C.M.

ANIL KHATRI
PRIMARY EXAMINER